

REMARKS

The last Office Action of July 24, 2003 has been carefully considered. Reconsideration of the instant application in view of the foregoing amendments and the following remarks is respectfully requested.

Claims 1-14 are pending in the application. Claims 11-14 have been withdrawn from further consideration. No claims have been amended, canceled or added.

Claims 1, 5, 6, 10 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 3,742,595 to Lykes in view of U.S. Pat. No. 6,222,289 to Adames.

Claims 2-4, 7-9 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Lykes in view of Adames, and further in view of U.S. Pat. No. 3,135,884 to Luenberger.

The rejection under 35 U.S.C. 103(a) is respectfully traversed.

The present invention is directed to a stator in which each winding end portion is received in a cavity which is bounded by a cooling jacket, a tubular insulator and a side of the laminated core, and which is filled with an insulating casting material to encase the winding end portion.

The Lykes reference describes a stator with a laminated core and winding end portions which are each received in a space defined by a frame (10), an end frame (11; 12) which is secured to the frame via a tenon fitting, a side of the laminated core (6), and a tubular liner (7). The space is filled with plastic material

to encapsulate the winding end portion. As the Examiner correctly pointed out Lykes fails to disclose the provision of an outer cooling jacket and the provision of the end frame of insulating material. However, in addition, the Examiner appears to ignore the fact that the space for each of the winding end portions in Lykes is bounded by **three** elements (not counting the laminated core). As clearly shown in Figs. 1 and 2, omission of any of these three elements would result in an undesirable open space. For example, absence of the liner 7 would allow injected plastic material to migrate into the rotor compartment.

In contrast thereto, the cavity of the stator according to the present invention is bounded two elements only (again disregarding the laminated core), namely the cooling jacket and the tubular insulator.

The Adames reference has been applied merely because of the description of a cooling unit for an electric machine. Nothing in Adames relates to the configuration of the stator in the area of the winding end portion. Please note that the present invention, as set forth in claims 1 and 6, does not intend to protect the combination of a stator with a cooling jacket, but relates to a protection of a configuration of the stator in the area of the winding end portion. Therefore, it is applicant's contention that an artisan confronted with the problems, as the inventor, would not find any motivation to combine the Lykes reference with the Adames reference, as suggested by the Examiner.

Please note also that Adames describes a cooling unit in the form of helical or non-helical coils (see col. 12, lines 31 to 38), so that a combination of Lykes and Adames, as suggested by the Examiner, will not produce the subject

matter of claims 1 and 6. Apart from the afore-mentioned differences between Lykes and the present invention, a combination of Lykes and Adames would require a modification of the Adames cooling unit to enable a placement over the stator in axial direction. As stated above, the Lykes reference employs tenon fittings for connecting the frame (11) to the outer frame (10). Thus, it is not possible to simply replace the outer frame (10) with the cooling unit of Adames, and push the cooling unit over the stator because the tenon fittings would result in a configuration in which a direct heat conducting connection between the stator and the cooling unit is no longer possible.

It is well established that the fact that individual elements of the present invention can be found in the prior art is not determinative as to the question of obviousness. As stated by the Federal Circuit in *In re Rouffet*, 47 USPQ2d, 1453, 1457 "Most, if not all, inventions are combinations and mostly of old element. Therefore, an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be an illogical and inappropriate process by which to determine patentability." The Examiner appears to rely upon hindsight to arrive at the determination of obviousness, because there is no teaching or suggestion supporting the combination as proposed by the Examiner. The mere

fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Gordon, 733 F.2d at 902.

It is applicant's contention, that the Examiner failed to make a prima facie case of obviousness and failed to explain the motivation one with no knowledge of applicant's invention would have to combine the references in a manner suggested

For the reasons set forth above, it is applicant's contention that neither Lykes nor Adames, nor a combination thereof teaches or suggests the features of the present invention, as recited in claims 1 and 6.

As for the rejection of the retained dependent claims, these claims depend on claims 1 and 6, share their presumably allowable features, and therefore it is respectfully submitted that these claims should also be allowed.

In view of the above presented remarks and amendments, it is respectfully submitted that all claims on file should be considered patentably differentiated over the art and should be allowed.

Reconsideration and allowance of the present application are respectfully requested.

Should the Examiner consider necessary or desirable any formal changes anywhere in the specification, claims and/or drawing, then it is respectfully requested that such changes be made by Examiner's Amendment, if the Examiner feels this would facilitate passage of the case to issuance. If the

Examiner feels that it might be helpful in advancing this case by calling the undersigned, applicant would greatly appreciate such a telephone interview.

Respectfully submitted,

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